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Filing date: **05/19/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221438
Party	Defendant YLD Limited
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Date	05/19/2015
Attachments	05 19 15 Cert of Service for MTD.pdf(86984 bytes) 05 19 15 Motion to Dismiss Opposition (ex).pdf(186997 bytes) 05 19 15 Matz Decl In Support of YLD MTD (WITH EXHIBITS).pdf(2033334 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial. No.: 86/174,797
Mark: THE NODE FIRM
IC: 042
Applicant: YLD Limited
Filed: January 24, 2014

-----X
THE NODE FIRM, LLC

Opposition No.: 91221438
Serial No.: 86174797

Opposer,

v.

YLD LIMITED,


Applicant.

-----X

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 19th day of May, 2015, a true and accurate copy of the foregoing **DECLARATION OF SARAH MATZ IN SUPPORT OF APPLICANT'S MOTION TO DISMISS OPPOSER'S OPPOSITION WITH EXHIBITS and MOTION TO DISMISS THE NODE FIRM LLC'S OPPOSITION PURSUANT TO RULE 12(B)(1) OF THE FEDERAL RULES OF CIVIL PROCEDURE** was served within the time permitted by the Board rules *via* first class mail and electronic mail for delivery to the following addressee(s):

Erica D. Klein
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, NY 10036
KLTrademark@KramerLevin.com

Dated: 5/19/15 Signature: 
SARAH M. MATZ

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial. No.: 86/174,797

Mark: THE NODE FIRM

IC: 042

Applicant: YLD Limited

Filed: January 24, 2014

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THE NODE FIRM, LLC

Opposition No.: 91221438

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Opposer,

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YLD LIMITED,

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**MOTION TO DISMISS THE NODE FIRM, LLC'S
OPPOSITION PURSUANT TO RULE 12(B)(1) OF THE
FEDERAL RULES OF CIVIL PROCEDURE**

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Applicant YLD Limited (“Applicant” or “YLD”), through its undersigned counsel, moves the Board to dismiss the Petition for Opposition (“Opposition”) filed by The Node Firm, LLC (“Opposer”) against Application Serial No. 86/174,797 (the “Application”), pursuant to Rule 12(b)(1) of the Federal Rules of Civil Procedure, and the Trademark Trial and Appeal Board’s (the “Board”) Manual of Procedure (“TBMP”) on the grounds that the Opposition was untimely and as such the Board lacks jurisdiction over this proceeding.

PRELIMINARY STATEMENT

It is well settled law that the Board lacks jurisdiction over an opposition proceeding filed outside of the time proscribed by statute, and any extensions thereof. The facts here are very straight forward. This opposition proceeding, filed five (5) months after the time to oppose the Application expired, is untimely and as such must be dismissed for lack of jurisdiction. The Node Firm LLC did not request any extension of time to oppose the Application, nor was it granted any such extension. Additionally, although The Node Firm LLC has made the conclusory allegation that it is in “privity” with a separate entity that requested two (2) extensions, there has been no showing of such privity here, nor are there facts pled in the Opposition that would satisfy the standard of making a “showing” of privity pursuant to the TBMP. As Opposer has failed to make this showing, through its pleading or otherwise, Opposer cannot claim that it should be entitled to the benefit of the extensions granted to non-party The Node Source, LLC. The Opposition is untimely and must be dismissed as the Board has no jurisdiction.

STATEMENT OF FACTS

On or about January 24, 2014, Applicant filed an application for the “THE NODE FIRM” word mark (the “Mark”), Serial No. 86174797 for “Computer programming; Computer programming consultancy; Computer software consulting; Computer software development and

computer programming development for others; Creating of computer programs” in IC 042 (the “Application”).

The Application was published for opposition on or about October 7, 2014, and the deadline to oppose said application expired on or about November 7, 2014. On or about November 5, 2014, non-party Node Source, LLC requested a ninety (90) day extension of time to file a notice of opposition to oppose YLD’s Application. *See* Matz Aff. Ex. 1. Non-party Node Source LLC’s request was granted on or about November 5, 2014. *See* Matz Aff. Ex. 2. On or about February 4, 2015, non-party Node Source, LLC requested a second, sixty (60) day extension of time to file a notice of opposition. *See* Matz Aff. Ex. 3. Non-party Node Source, LLC’s second request was granted on or about February 4, 2015. *See* Matz Aff. Ex. 4. On or about April 6, 2015, a different entity The Node Firm, LLC, the Opposer in the within proceeding, filed the instant Opposition. *See* Matz Aff. Ex. 5.

The Node Firm LLC, was not the entity that had been granted extensions of time to oppose the Application, and as a reason for not filing its Opposition timely pled that:

Extensions of time to oppose the Offending Application were filed in the name of Node Source, LLC, a limited liability company duly formed and existing under the laws of the State of Texas, and granted by the Board, providing until April 5, 2015 (in effect the next business day thereafter, i.e. April 6, 2015) to file an opposition. Node Source, LLC, now NodeSource, Inc., a corporation duly formed and existing under the laws of the State of Delaware, is in privity with The Node Firm for purposes of TBMP § 206.02.¹

See Matz Aff. Ex. 5 (at pg 1). Other than the above quoted allegation in Opposer’s introductory statement in its Opposition, Opposer failed to plead any other facts concerning the relationship between itself and Node Source, LLC, nor is there any other information in the record that

¹ By virtue of citation to any of the allegations in Opposer’s Opposition, Applicant does not concede that any of the facts as alleged therein are true and nothing herein shall be deemed an admission or concession of any of the facts alleged in the Opposition.

demonstrates the relationship between the parties.

LEGAL STANDARD

Pursuant to TBMP § 201, any person who believes that he would be damaged by the registration of a mark upon the principal register “may . . . file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered.” *See* TBMP §201.

“Because the timeliness requirements of Trademark Act § 13(a), 15 U.S.C. § 1063(a), for the filing of an opposition are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Board or by the Director on petition. Accordingly, an opposition filed after the expiration of the would-be opposer’s time for opposing must be denied by the Board as late. . . The would-be opposer’s remedy lies in the filing of a petition for cancellation, pursuant to Trademark Act § 14, 15 U.S.C. § 1064 when and if a registration is issued.” TBMP 306.04

While the time to oppose may be extended “[a]ny opposition filed during an extension of time should be in the name of the person to whom the extension was granted.” 37 C.F.R. §2.102. The only exceptions to that rule are that “[a]n opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.” 37 C.F.R. §2.102. *See also* TBMP 206.01(b).

To satisfy the privity exception, the would-be opposer must show “to the satisfaction of the Board that the differing party is in privity with the party granted the extension.” TBMP 303.05(b). “The ‘showing’ of privity should be in the form of a recitation of the facts on which the claim of privity is based, and must be submitted either with the opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.” *See* TBMP 303.05(b).

Additionally, as will all matters of pleading, the opposition petition “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face . . . In particular, the claimant must allege well-pleaded factual matter and more than ‘[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,’ to state a claim plausible on its face.” *Caymus Vineyards*, 2013 WL 6665451, at *2 (July 12, 2013) (applying the standards of *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007) and *Ashcroft v. Iqbal*, 556 U.S. 662, 679 (2009) on a motion to dismiss).

ARGUMENT

Here Opposer The Node Firm LLC did not obtain any extension of time to oppose Applicant’s Mark and its pleading fails to allege any facts, as required by TBMP 303.05(b) and 206.02, that would allow the Board to find that there was a sufficient showing that privity exists between The Node Firm LLC, the Opposer, and non-party Node Source, LLC, the entity that filed and was granted the extensions.

Pursuant to the TBMP, the “showing” of privity that is required to be submitted with the Opposition, should be “in the form of a recitation of the facts on which the claim of privity is based”. *See* TBMP 303.05(b). Here Opposer has failed to recite any facts upon which the claim of privity is based. Opposer The Node Firm, LLC has only made a one sentence conclusory allegation that non-party Node Source LLC “is in privity with The Node Firm for purposes of TBMP § 206.02”. *See* Matz Aff. Ex. 5. The Opposition offers no factual allegations that would support or even imply that privity actually exists and as such Opposer’s Opposition fails to satisfy the requirements of TBMP § 206.02 and 303.05(b) i.e. to recite facts upon which the claim of privity is based. As such this Opposition was untimely and thus the Board lacks jurisdiction over the proceeding.

Whether an opposition has been timely filed is a threshold jurisdictional matter. Where an

opposition is not timely filed the “Board has no jurisdiction to entertain it.” *Cass Logistics Inc.*, 27 U.S.P.Q.2d 1075 (PTO Apr. 27, 1993) (granting motion to dismiss for lack of jurisdiction where party that filed opposition was a different entity than the party that requested the initial extension and the opposer failed to make a showing of privity or mistake).

Where an opposer relying on extensions requested by a different entity fails to show that it is in privity with the entity that requested the extensions, there is no basis upon which the opposer can claim the benefit of the requesting party’s privilege in an extension of time to oppose an application, and the opposition should be dismissed for lack of jurisdiction. *See Renaissance Rialto Inc. v Ky Boyd*, 107 U.S.P.Q.2d 1083 (PTO May 31, 2013) (Since opposer did not file the notice of opposition during the proper time, and is not in privity with the party that did so, the Board has no jurisdiction).

In *Renaissance Rialto Inc.*, the Board granted applicant’s motion dismissing opposer’s opposition on the ground that the opposer had failed to show that it was in privity with the party that requested and was granted extensions of time to oppose registration of the mark RIALTO CINEMAS. The Board found that the opposer had failed to show that it was a successor to any proprietary interest in the mark, nor had it shown that it was in the position of a parent-subsidiary, licensor-licensee or any other relationship in respect of prior rights in the mark, and as such had not shown a sufficient basis “upon which to claim the benefit of the transferor’s personal privilege in an extension of time to oppose the application.” *See id.* As the opposer’s filing date was outside of the 30 days allotted for initiating an opposition or requesting an extension of time to do so and since “opposer did not file the notice of opposition during the proper time, and [was] not in privity with the party that did so, [the Board had] no jurisdiction.” *See id.*

Here, the Opposer The Node Firm LLC, has failed to recite any facts upon which its claim of privity is based, nor is there any other information in the record that would allow the Board to find that The Node Firm LLC and Node Source, LLC are actually in privity. Opposer The Node Firm

LLC, has only made the conclusory allegation that it is in “privity” with Node Source LLC. Without more, The Node Firm LLC’s bare allegation is insufficient pursuant to the requirement that the opposer plead a “recitation of the facts on which the claim of privity” is based. *See* TBMP 303.05(b). Threadbare conclusory statements such as this are also insufficient as a matter of law under the pleading standard required by *Iqbal* and *Twombly*. *See e.g. Iqbal*, 556 U.S. 662 (claimant must allege well pleaded factual matter, more than threadbare recitals and conclusory statements).

The Node Firm LLC has failed to satisfy the requirement that it to plead facts that would support a finding of privity or other basis upon which Opposer The Node Firm LLC could claim the benefit of Node Source, LLC’s privilege in the extensions of time to oppose the application. The Node Firm LLC cannot be entitled to the benefit of the extension, and as its Opposition here was filed after the statutory period to file an opposition expired, it should be denied as untimely.

CONCLUSION

Based upon the foregoing, Opposer’s Opposition is untimely and must be dismissed for lack of jurisdiction. Opposer’s remedy is to file a petition for cancellation should the registration issue.

Dated: New York, New York
May 19, 2015

Respectfully Submitted,

ADELMAN MATZ P.C.



By: Sarah Matz, Esq.
Gary Adelman, Esq.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial. No.: 86/174,797
Mark: THE NODE FIRM
IC: 042
Applicant: YLD Limited
Filed: January 24, 2014

-----X
THE NODE FIRM, LLC

Opposition No.: 91221438
Serial No.: 86174797

Opposer,

v.

YLD LIMITED,

Applicant.

-----X

**DECLARATION OF SARAH MATZ
IN SUPPORT OF APPLICANT'S MOTION TO DISMISS OPPOSER'S OPPOSITION**

SARAH M. MATZ, pursuant to 28 U.S.C. § 1746, declares under the penalty of perjury, as follows:

1. I am a partner at the law firm of Adelman Matz P.C., attorneys for Applicant YLD Limited ("YLD"). As such, I am fully familiar with the facts and circumstances herein based upon my personal handling of the file.
2. I make this declaration in support of YLD's motion to dismiss THE NODE FIRM LLC's ("Opposer") opposition.
3. A true and correct copy of the First 90 Day Request for Extension of Time to Oppose filed by NODE SOURCE, LLC on November 5, 2014, is annexed hereto as **Exhibit 1.**
4. A true and correct copy of the Board's November 5, 2014 order granting the request to extend time to oppose on behalf of NODE SOURCE LLC, is annexed hereto as **Exhibit 2.**

5. A true and correct copy of the 60 Day Request for Extension of Time to Oppose filed by NODE SOURCE, LLC, on February 4, 2015, is annexed hereto as **Exhibit 3.**

6. A true and correct copy of the Board's February 4, 2015 order granting the request to extend time to oppose on behalf of NODE SOURCE LLC, is annexed hereto as **Exhibit 4.**

7. A true and correct copy of the Notice of Opposition filed by THE NODE FIRM, LLC, on or about April 6, 2015 is annexed hereto as **Exhibit 5.**

I declare under penalty of perjury that the foregoing is true and correct.

Executed on May 19, 2015 in New York, New York.



SARAH M. MATZ, ESQ.

EXHIBIT 1

ESTTA Tracking number: **ESTTA637212**

Filing date: **11/05/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	YLD Limited
Application Serial Number:	86174797
Application Filing Date:	01/24/2014
Mark:	THE NODE FIRM
Date of Publication	10/07/2014

First 90 Day Request for Extension of Time to Oppose for Good Cause

Pursuant to 37 C.F.R. Section 2.102, Node Source LLC, c/o Kramer Levin Naftalis & Frankel LLP, 1177 Avenue of the Americas, New York, NY 10036, UNITED STATES, a Limited Liability Company, organized under the laws of Texas, respectfully requests that it be granted a 90-day extension of time to file a notice of opposition against the above-identified mark for cause shown.

Potential opposer believes that good cause is established for this request by:

- The potential opposer needs additional time to investigate the claim

The time within which to file a notice of opposition is set to expire on 11/06/2014. Node Source LLC respectfully requests that the time period within which to file an opposition be extended until 02/04/2015.

Respectfully submitted,

/Erica D. Klein/

11/05/2014

Erica D. Klein

Kramer Levin Naftalis & Frankel LLP

1177 Avenue of the Americas

New York, NY 10036

UNITED STATES

kltrademark@kramerlevin.com

EXHIBIT 2

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Erica D. Klein
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, NY 10036

Mailed: November 5, 2014

Serial No.: 86174797
ESTTA TRACKING NO: ESTTA637212

The request to extend time to oppose is granted until
2/4/2015 on behalf of potential opposer **Node Source LLC**

Please do not hesitate to contact the Trademark Trial and
Appeal Board at (571)272-8500 if you have any questions
relating to this extension.

Note from the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to
oppose, notices of opposition, petition for cancellation, notice
of ex parte appeal, and inter partes filings are now available
at <http://estta.uspto.gov>. Images of TTAB proceeding files can
be viewed using TTABVue at <http://ttabvue.uspto.gov>.

EXHIBIT 3

ESTTA Tracking number: **ESTTA653949**

Filing date: **02/04/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	YLD Limited
Application Serial Number:	86174797
Application Filing Date:	01/24/2014
Mark:	THE NODE FIRM
Date of Publication	10/07/2014

60 Day Request for Extension of Time to Oppose Upon Consent

Pursuant to 37 C.F.R. Section 2.102, Node Source LLC, c/o Kramer Levin Naftalis & Frankel LLP, 1177 Avenue of Americas, New York, NY 10036, UNITED STATES respectfully requests that he/she/it be granted an additional 60-day extension of time to file a notice of opposition against the above-identified mark with applicant's consent.

The time within which to file a notice of opposition is set to expire on 02/04/2015. Node Source LLC respectfully requests that the time period within which to file an opposition be extended until 04/05/2015.

Respectfully submitted,
/Erica D. Klein/
02/04/2015

Erica D. Klein

Kramer Levin Naftalis & Frankel LLP

1177 Avenue of Americas

New York, NY 10036

UNITED STATES

KLTrademark@KramerLevin.com

EXHIBIT 4

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Erica D. Klein
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, NY 10036

Mailed: February 4, 2015

Serial No.: 86174797
ESTTA TRACKING NO: ESTTA653949

The request to extend time to oppose is granted until
4/5/2015 on behalf of potential opposer **Node Source LLC**

Please do not hesitate to contact the Trademark Trial and
Appeal Board at (571)272-8500 if you have any questions
relating to this extension.

Note from the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to
oppose, notices of opposition, petition for cancellation, notice
of ex parte appeal, and inter partes filings are now available
at <http://estta.uspto.gov>. Images of TTAB proceeding files can
be viewed using TTABVue at <http://ttabvue.uspto.gov>.

EXHIBIT 5

ESTTA Tracking number: **ESTTA665207**

Filing date: **04/06/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The Node Firm, LLC
Granted to Date of previous extension	04/05/2015
Address	c/o Kramer Levin Naftalis & Frankel LLP 1177 Avenue of the Americas New York, NY 10036 UNITED STATES
Party who filed Extension of time to oppose	Node Source LLC
Relationship to party who filed Extension of time to oppose	Node Source, LLC, now NodeSource, Inc., is in privity with The Node Firm, LLC for purposes of TBMP Â§ 206.02.

Correspondence information	The Node Firm, LLC c/o Kramer Levin Naftalis & Frankel LLP 1177 Avenue of the Americas New York, NY 10036 UNITED STATES kltrademark@kramerlevin.com Phone:212-715-9205
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Applicant Information

Application No	86174797	Publication date	10/07/2014
Opposition Filing Date	04/06/2015	Opposition Period Ends	04/05/2015
Applicant	YLD Limited 32-38 Scrutton St. STE# 5 London,, EC2A4RQ UNITED KINGDOM		

Goods/Services Affected by Opposition

Class 042. First Use: 2011/11/28 First Use In Commerce: 2011/11/28 All goods and services in the class are opposed, namely: Computer programming; Computer programming consultancy; Computer software consulting; Computer software development and computer programming development for others; Creating of computer programs

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Void Ab Initio; Abandonment

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THE NODE FIRM		
Goods/Services	Computer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; creating of computer programs		

Related Proceedings	YLD Limited v. The Node Firm, LLC et al, Case No. 1:15-cv-00855-JPO (S.D.N.Y. Feb. 5, 2015)
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Attachments	Notice of Opposition.pdf(1877769 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Erica D. Klein/
Name	The Node Firm, LLC
Date	04/06/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. : 86/174,797
Mark : THE NODE FIRM
International Class : 42
Applicant : YLD Limited
Filed : January 24, 2014
Published : October 7, 2014

-----X		
The Node Firm, LLC	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.
	:	
YLD Limited	:	
	:	
Applicant.	:	
	:	
-----X		

NOTICE OF OPPOSITION

The Node Firm, LLC, a limited liability company duly formed and existing under the laws of the State of Texas ("Opposer"), believes that it would be damaged by a grant of a registration to YLD Limited, a foreign corporation duly formed and existing under the laws of the United Kingdom ("Applicant"), applicant for Application Serial No. 86/174,797 for the mark THE NODE FIRM (the "Offending Mark") filed in International Class 42 on January 24, 2014, and published for opposition on October 7, 2014 (the "Offending Application"), and hereby opposes said Offending Application. Extensions of time to oppose the Offending Application were filed in the name of Node Source, LLC, a limited liability company duly formed and existing under the laws of the State of Texas, and granted by the Board, providing until April 5, 2015 (in effect the next business day thereafter, i.e. April 6, 2015) to file an opposition. Node

Source, LLC, now NodeSource, Inc., a corporation duly formed and existing under the laws of the State of Delaware, is in privity with The Node Firm for purposes of TBMP § 206.02.

The grounds for opposition are set forth below.

I. BACKGROUND

A. Opposer.

1. Opposer is the owner of common law rights in the name and mark THE NODE FIRM (“Opposer’s Mark”), which such name and mark has been used by or on behalf of Opposer since at least as early as November 28, 2011 in connection with services including computer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; and creating of computer programs (“Opposer’s Services”).

2. Through Opposer’s long term use of Opposer’s Mark in connection with Opposer’s Services, Opposer’s Mark has acquired secondary meaning as a source of Opposer’s Services.

3. Through Opposer’s long term use of Opposer’s Mark in connection with Opposer’s Services, Opposer’s Mark has acquired significant value and goodwill.

4. Through Opposer’s long term use of Opposer’s Mark in connection with Opposer’s Services, Opposer’s Mark is closely associated with Opposer, its owners and employees, and work performed by them or on their behalf.

B. Applicant.

5. The Offending Application seeks registration of the Offending Mark for use in connection with Computer programming; Computer programming consultancy; Computer software consulting; Computer software development and computer programming development for others; Creating of computer programs in International Class 42 (the “Offending Services”).

6. The Offending Application was filed on January 24, 2014 (the "Filing Date") based on Section 1(a) of the Trademark Act.

7. The Offending Application alleges November 28, 2011 as the date that the Offending Mark was first used by Applicant in connection with the Offending Services, and as the date that the Offending Mark was first used in commerce by Applicant in the United States in connection with the Offending Services.

II. GROUNDS FOR OPPOSITION

A. The Offending Application is Void *Ab Initio* Because Applicant Had No Use of the Offending Mark in Connection with the Offending Services Prior to the Filing Date.

8. Upon information and belief, the Offending Mark was not created by Applicant or any predecessor thereof.

9. Upon information and belief, Applicant is a foreign corporation that operates under the laws of the United Kingdom.

10. Upon information and belief, the LinkedIn profile for Applicant, a true and correct copy of which is attached as Exhibit A hereto, indicates that Applicant was formed in 2013.

11. Upon information and belief, since its formation, Applicant has not used the Offending Mark in connection with the Offending Services.

12. Upon information, Applicant, for its own behalf, has never used the Offending Mark in connection with any of the Offending Services.

13. Because Applicant was not rendering the Offending Services at the time it filed its use-based application for the Offending Mark, the Offending Application is void *ab initio*.

B. The Offending Application is Void *Ab Initio* Because the Services Applicant Relied Upon to Support the Offending Application Were Performed for the Benefit of Opposer.

14. Opposer repeats and realleges the allegations stated in Paragraphs 1- 13 hereof and incorporates the same by reference as though fully restated herein.

15. Upon information and belief, Mr. Nuno Job ("Job") is a founder of Applicant.

16. Upon information and belief, prior to founding Applicant, Job offered services including computer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; and creating of computer programs as part of a collaboration with persons including founders of Opposer.

17. All computer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; and creating of computer programs performed by Job under the Offending Mark were performed on behalf of Opposer or a predecessor thereof.

18. Because the Offending Services performed by Job under the Offending Mark were performed on behalf of Opposer or a predecessor thereof, Job had no rights in the Offending Mark as a result of his performance of any Offending Services.

19. Job's performance of the Offending Services under the Offending Mark do not inure to the benefit of Applicant.

20. Job's performance of the Offending Services under the Offending Mark are an insufficient basis for Applicant to support the Offending Application.

21. The Offending Application is void *ab initio* because any Offending Services rendered by Job under the Offending Mark did not inure to the benefit of Applicant or a predecessor thereof (and instead inured to the benefit of Opposer or a predecessor thereof), and

thus the Offending Services had not been performed on behalf of Applicant or a predecessor thereof at the time Applicant filed its use-based application for the Offending Mark.

C. The Offending Application is Void Because Applicant Committed Fraud on the PTO.

22. Opposer repeats and realleges the allegations stated in Paragraphs 1-21 hereof and incorporates the same by reference as though fully restated herein.

23. Upon information and belief, Applicant knew at the time that it executed and filed the Offending Application that Applicant was not rendering the Offending Services at the time it filed its use-based application for the Offending Mark.

24. Upon information and belief, Applicant knew at the time that it executed and filed the Offending Application that any Offending Services performed by Job did not inure to the benefit of Applicant or any predecessor thereof.

25. Upon information and belief, Applicant knew at the time that it executed and filed the Offending Application that any Offending Services performed by Job were performed for the benefit of Opposer or a predecessor thereof.

26. Upon information and belief, Applicant knew at the time that it executed and filed the Offending Application that the Offending Mark was not in use in commerce by or on behalf of Applicant in connection with the Offending Services.

27. Upon information and belief, Applicant knew at the time it executed and filed the Offending Application that the specimens submitted in support of the Offending Application, true and correct copies of which are attached hereto as Exhibit B (the "Specimens"), were not actually in use in commerce by or on behalf of Applicant.

28. Upon information and belief, Applicant knew at the time it executed and filed the Offending Application that the Specimens did not show use in commerce by or on behalf of Applicant in the rendering or advertising of the Offending Services.

29. Upon information and belief, by filing the Offending Application, representing that the Offending Mark was in use in commerce by Applicant in the United States in connection with the Offending Services, Applicant knowingly made a false, material representation with the intent to deceive the United States Patent and Trademark Office ("PTO").

30. Upon information and belief, as a result of the aforementioned acts of Applicant, the PTO relied on Applicant's false statement that the Offending Mark was in use in commerce by Applicant in the United States in connection with the Offending Services, and thereby approved the Offending Application for publication.

31. Upon information and belief, Applicant's fraud in the execution and filing of the Offending Application requires that the Offending Application be deemed void and that this opposition be sustained.

D. The Offending Mark is Descriptive, and Applicant Has Not Established the Requisite Secondary Meaning to Support Registration.

32. Opposer repeats and realleges the allegations stated in Paragraphs 1-31 hereof and incorporates the same by reference as though fully restated herein.

33. The Offending Mark is comprised of the term THE NODE FIRM.

34. The word NODE describes Node.js, which is an open source, cross-platform runtime environment for server-side and networking applications.

35. The word FIRM describes a type of business organization.

36. The Offending Mark is merely descriptive under §2(e)(1) of the Trademark Act, as it describes a characteristic and purpose of the Offending Services recited in the Offending Application, namely, a business organization that performs computer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; and creating of computer programs, in the Node.js programming language.

37. To be registerable on the Principal Register, the Offending Mark must have acquired distinctiveness.

38. Because Applicant has not established acquired distinctiveness of the Offending Mark, and for the reasons stated above could not establish acquired distinctiveness of the Offending Mark, Applicant is not entitled to registration of the Offending Mark covered by the Offending Application.

E. The Offending Mark Has Been Abandoned by Applicant.

39. Opposer repeats and realleges the allegations stated in Paragraphs 1-38 hereof and incorporates the same by reference as though fully restated herein.

40. Opposer alleges in the alternative that, if Applicant, or any predecessor thereof, has at any time used the Offending Mark in connection with the Offending Services on Applicant's behalf: (a) the Offending Mark has not been used in connection with the Offending Services by or on behalf of Applicant or any predecessor thereof for several years; and (b) Applicant has an intent not to resume use of the Offending Mark in connection with the Offending Services.

F. Any Use of the Offending Mark on Applicant's Behalf Falsely Suggests a Connection with Opposer.

41. Opposer repeats and realleges the allegations stated in Paragraphs 1-40 hereof, as applicable, and incorporates the same by reference as though fully restated herein.

42. Through Opposer's use of THE NODE FIRM to identify Opposer's Services, such mark has acquired significant value and goodwill as a source of Opposer's Services, and is closely associated with Opposer, its owners and employees, and work performed by them or on their behalf.

43. Opposer alleges in the alternative that, if Applicant, or any predecessor thereof, has at any time used the Offending Mark in connection with the Offending Services on

Applicant's behalf, such use falsely suggests a connection with Opposer, and therefore violates the rights of Opposer under Section 2(a) of the Trademark Act.

G. Any Use of the Offending Mark on Applicant's Behalf is Likely to Cause Confusion with Opposer's Mark.

44. Opposer repeats and realleges the allegations stated in Paragraphs 1-43 hereof, as applicable, and incorporates the same by reference as though fully restated herein.

45. Opposer alleges in the alternative that, if Applicant, or any predecessor thereof, has at any time used the Offending Mark in connection with the Offending Services on Applicant's behalf, such use is likely to cause confusion with Opposer's Mark and therefore violates the rights of Opposer under Section 2(d) of the Trademark Act.

WHEREFORE, Opposer requests that this opposition be sustained and that Application Serial No. 86/174,797 for the mark THE NODE FIRM be refused registration.

This Notice is being filed electronically with the Board, and is being served on Applicant, through its attorney of record, at Applicant's correspondence address of record with the PTO. Proof of Service is attached hereto.

Respectfully submitted,

Dated: New York, NY
April 6, 2015

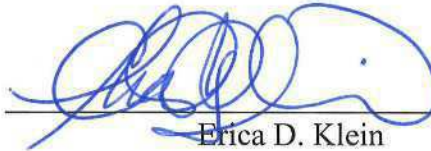
KRAMER LEVIN NAFTALIS & FRANKEL LLP
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CERTIFICATE OF SERVICE

I hereby certify that on April 6, 2015, I caused one true and correct copy of the foregoing Notice of Opposition against U.S. Application No. 86/174,797 for THE NODE FIRM, and accompanying Exhibits, to be served by first class mail upon YLD Limited, by causing a true and correct copy thereof to be deposited in the United States mail, postage prepaid, addressed to Applicant's attorney of record, at the correspondence address of record with the PTO as follows:

Sarah M. Matz
Adelman Matz P.C.
1173A Second Avenue, Suite 153
New York, NY 10065



Erica D. Klein

Opposition filed against
Application No. 86/174,797
The Node Firm, LLC v. YLD Limited
Exhibit A Filed by The Node Firm, LLC

EXHIBIT A

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From concept to product we build high performance, stable node.js products. Responsible for some of the largest Node.js solutions in production today. We are based in London. Created by Nuno Job and Pedro Teixeira, engineers responsible for the Nodejitsu Cloud.

Specialties

Node.js, Consulting, Docker, Training

Website<http://yld.io>**Industry**

Computer Software

Type

Privately Held

Headquarters32-38 Scruton St, Suite 5 London,
EC2A 4RQ United Kingdom**Company Size**

1-10 employees

Founded

2013

YLD employees**14** Employees on LinkedIn[See how you're connected](#)**Ads You May Be Interested In****Is Your Company Listed?**List your Consumer Goods
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Opposition filed against
Application No. 86/174,797
The Node Firm, LLC v. YLD Limited
Exhibit B Filed by The Node Firm, LLC

EXHIBIT B





Get Started Today **FREE TRIAL**

The Node Firm and Joyent Offer Node.js Training

August 28, 2013 - by The Node Firm

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This post originally appeared on The Node Firm Blog.

Since its inception, The Node Firm has been the go-to choice for corporate Node.js training. We're excited to begin offering open enrollment training too. We are launching our public trainings at the home of Node.js at Joyent in San Francisco. Custom tailored training doesn't fit all budgets and some teams are just so lean that flying in experts doesn't make sense. We hope you come join us for these inaugural sessions.

Increased Demand for Professional Training

Node.js has become the number one choice for creating scalable, efficient, realtime services. This has led to an increasing need to train developers in Node.js from startups to government to Fortune 100 corporations. Companies like Walmart, Mozilla, Microsoft, Yahoo and others have been relying on Node.js in the production space since 2010. Node has now become the default choice for new development, enabling rapid development with robust scalability and unparalleled ease of use for developers.

“The simple truth is, Node has reinvented the way we create webapps. Developers want to use Node.js in their apps, not learn it.” - Michael Kretzmer, AWS Product Operations

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Joyent is the high performance cloud infrastructure and big data analytics company, offering organizations of any size the best public and hybrid cloud infrastructure for today's demanding real-time web and mobile applications.



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